



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/671,059 | 09/25/2003 | Kyle N. Patrick | CA920020057US1 | 5839 |
| 46073 | 7590 | 12/12/2007 | | |
| IBM CORPORATION (VE) C/O VOLEL EMILE P. O. BOX 162485 AUSTIN, TX 78716 | | | EXAMINER KEEFER, MICHAEL E | |
| | | | ART UNIT 2154 | PAPER NUMBER |
| | | | MAIL DATE 12/12/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/671,059
Filing Date: September 25, 2003
Appellant(s): PATRICK, KYLE N.

MAILED

DEC 12 2007

Technology Center 2100

Volel Emile
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/28/2007 appealing from the Office action
mailed 4/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. The rejections of claims 11-30 under 35 U.S.C. 101, the rejection of claims 1 and 3 under 35 U.S.C. 102(b) as anticipated by Hara (US 5938725), the rejection of claims 1-3, 5, 11-13, 15-16, 21-23, and 25-26 under 35

U.S.C. 102(b) as anticipated by Birrell et al., and the rejection of claims 1-4, 7, 11-14, 17-20, 21-24, and 27-30 under 35 U.S.C. 102(e) as anticipated by Ullmann et al. (US 7103634). The applicant, by not appealing these rejections, is admitting agreement with these rejections.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|----------------|--------|
| 6,189,026 | Birrell et al. | 2-2001 |
| 7,103,634 | Ullmann et al. | 9-2006 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 11**, which is drawn to "a computer program product". In order for a claim to be statutory it must be drawn to a process, article of manufacture, composition of matter, or machine. In accordance with Applicant's specification "a computer usable medium" may include "a computer readable modulated carrier signal". (Page 5, paragraph 2) This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine,

Art Unit: 2154

manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 12-20 do not remove any non-statutory matter from the claim, therefore are rejected for the same.

Regarding claim 21, which is drawn to an article comprising a modulated carrier signal. Applicant's specification on page 5 in paragraph 2 states, "The invention may also be embodied on a computer readable modulated carrier signal." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and therefore are rejected for the same.

In addition, **claim 21** is directed merely to functional descriptive material as stated in applicant's specification on page 5 in paragraph 2, "[The present invention] may also be embodied as ... computer software code ..." This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes functional descriptive material. Functional descriptive material does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 22-30 do not remove the non-statutory subject matter from the claim and therefore are rejected for the same.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara (US 5938725).

Regarding **claim 1**, Hara discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (storage means for storing therein a received electronic mail Col 2. lines 58-59)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses; (extracting means for extracting a mail address contained in the electronic mail Col. 2 lines 64-65, it is inherent that previous senders of a chain email are also previous receivers)

iii) displaying said list of parsed e-mail addresses; (Col 4 Lines 2-8, "outputted as the transmission destination candidates") and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 4 lines 8-11 "the user can readily transmit the electronic mail by merely selecting his desired transmission destination from these outputted transmission destination candidates.)

Regarding claim 3 and as applied to claim 1 Hara discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 3, lines 4-9, the user inputting a keyword from an input device starts the process of extraction.)

4. Claims 1-3, 5-6, 11-13, 15-16, 21-23, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Birrell et al. (US 6189026 B1) hereafter Birrell.

Regarding **claims 1, 11, and 21**, Birrell discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (“Mail messages are stored in message files of the mail service system” Abstract)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 12, lines 16-18 “the system heuristically locates text strings which have the syntax of email addresses”, it is inherent that previous senders of a chain email are also previous receivers)

iii) displaying said list of parsed e-mail addresses; (Col 12 lines 18-19 “if the user clicks on one of these addresses, inherently the list of addresses must be displayed in order for a user to click on them) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and
iv) forming a reply e-mail message to recipients selected from said list by said user. (Col 12 lines 18-21 "If a user clicks on one of these addresses then the system will display a composition window so that the user can easily generate a reply message to the selected email address(es).")

Birrell discloses that his method can be computer implemented, therefore must be able to be implemented on a computer readable media as recited in claim 11 or a computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said received e-mail message is a multi-party e-mail. (The reply to all function described in Col 14 lines 36-38 clearly shows that emails with multiple parties are included by the disclosed email system.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Col 12, lines 16-17 disclose that "When displaying retrieved messages" and choosing to display a message is a user action.)

Regarding **claim 5, 15, and 25 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically prior to said user action. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

Regarding **claim 6, 16, and 26 and as applied to claims 1, 11, and 21**, Birrell discloses:

wherein said recipient computer parses said received e-mail message automatically upon receipt of said message. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7-10, 11-14, 17-20, 21-24, 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ullmann et al. (US 7103634 B1) hereafter Ullmann.

Regarding **claims 1, 11, and 21**, Ullmann discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer;
(this step is inherent as the message must be stored in memory of the computer)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 8 lines 55-57 "scanning the attached or inline header fields of the original message", it is inherent that the parsed email addresses will comprise both the previous senders and recipients if the inline header fields are all parsed.)

iii) displaying said list of parsed e-mail addresses; (the "special field" disclosed in line 54 would display the results of the scanning above) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built list of previous senders and recipients can be used to provide automatic addressing for a reply or forwarded message.)

Ullmann discloses that his method can be computer implemented, therefore must be able to be implemented on a computer readable media as recited in claim 11 or a computer readable carrier wave as recited by claim 21.

Regarding **claims 2, 12, and 22 and as applied to claims 1, 11, and 21**,
Ullmann discloses:

wherein said received e-mail message is a multi-party e-mail. (Ullmann specifically discloses that chain messages (i.e. multi-party emails) are processed using his method, "An enhanced e-mail reader and composer having automatic addressing functions to create and manage chain groups for organizing chain-forwarded and chain-replied messages" abstract.)

Regarding **claims 3, 13, and 23 and as applied to claims 1, 11, and 21**,
Ullmann discloses:

wherein said list of parsed e-mail addresses is displayed in response to an action by a user. (Fig. 4 of fully incorporated application 09/672,181 where the step of opening and displaying an email is directly followed by the scanning of the email, therefore the act of the user opening the email causes the scanning.)

Regarding **claims 4, 14, and 24 and as applied to claims 1, 3, 11, 13, 21, and 23**, Ullmann discloses:

wherein said user action comprises initiating a reply message. (Col 10, lines 21-42, where it is described that after a reply message is started a list of possible recipients, "one or more found previous recipients and originators" in lines 34-35)

Regarding **claims 7, 17, and 27 and as applied to claims 1, 11, and 21**,
Ullmann discloses:

wherein said recipient computer loads and displays said received email for viewing by said user prior to said parsing step. (In fully incorporated application 09/672181, Col. 6 lines 14-16 states that first the message is opened and displayed, then it is scanned.)

Regarding claims 8, 18, and 28 and as applied to claims 1, 11, and 21,

Ullmann discloses:

wherein prior to said parsing step said user requests a list of potential reply e-mail addresses. (Col 10, when the user asks to make a reply message, the message is parsed in order to find possible reply candidates as inherently part of forming a reply requires a user to specify to whom the message is going to.

Regarding claims 9, 19, and 29 and as applied to claims 1, 11, and 21,

Ullmann discloses:

wherein said response message is formed by auto-populating SMTP headers with said list of e-mail addresses (Col. 9 lines 18-22 disclose populating the reply-to field of the email automatically with the addresses found in the search of the email.)

Regarding claims 10, 20, and 30 and as applied to claims 1, 11, and 21,

Ullmann discloses:

wherein said response message is formed by auto-populating user interface graphical elements. (Col 10 lines 29-36 describes that the user is prompted to create an address book entry for a group, in which the group is automatically filled with addresses found in the search of the email.)

(10) Response to Argument

Regarding claim 6, Appellant argues that Birrell does not teach performing the step of parsing an e-mail message for e-mail addresses of previous senders and recipients as soon as the e-mail message is received.

As stated in the above rejection of claim 6 over Birrell, in Col. 7 lines 23-24 state that newly received messages are processed in batches as they are received. This means that as soon as it is received, the message is placed in a batch to be parsed by the parsing algorithm as described in the paragraph between lines 45-54 in col. 7.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 16 and 26 under 35 U.S.C. 102(b) over Birrell, which contain essentially the same subject matter as claim 6, admitting the propriety of those rejections.

Regarding claim 8, Appellant argues that Ullmann does not disclose the step of requesting a list of potential reply e-mail addresses prior to parsing for e-mail addresses of the previous senders and recipients.

Ullmann discloses a request for potential reply e-mail addresses prior to parsing the e-mail in a few ways.

First, in Col. 8, lines 50-58, Ullmann states that after a user has send a request to forward an email, he is provided a list of possible recipients of the email -then- a special list of addresses generated by scanning the inlined header fields of the original message. Therefore, as the limitation of the claim requires, the message is "parsed" for reply e-mail addresses -after- a request for potential reply addresses. (The request to forward/reply to the message is a request for potential reply addresses.)

Secondly, in Col. 10, lines 20-52, it is described that after a user requests to make a new message, a reply message, or to forward a message, the previous email is scanned (i.e. parsed) for previous recipient and sender e-mail addresses.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 18 and 28 under 35 U.S.C. 102(e) over Ullmann, which contain essentially the same subject matter as claim 8, admitting the propriety of those rejections.

Regarding claim 9, Appellant argues that Ullmann does not disclose auto-populating headers with the list of e-mail addresses.

As stated in the above rejection of claim 9 over Ullmann, Col. 9 lines 18-22 disclose the feature of populating headers of an e-mail message with the list of e-mail addresses. Tables 7 and 8 shows headers (SMTP headers, note especially Table 8, which places the list of e-mail addresses in the "Reply-to" header) that have the list of parsed email addresses within them.

Furthermore, in the process of sending the email, it is inherent in sending an email that at least the "To:" field of a e-mail message must be populated with the recipients of an email message.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 19 and 29 under 35 U.S.C. 102(e) over Ullmann, which contain essentially the same subject matter as claim 9, admitting the propriety of those rejections.

Regarding claim 10, Appellant argues that Ullmann does not disclose auto-populating user interface graphical elements with the list of e-mail addresses.

As stated in the above rejection of claim 10 over Ullmann, Col. 10 lines 29-36 disclose this limitation. "He may also associate one or more of the found previous recipients and originators..." In order for a user to be able to perform the action of

Art Unit: 2154

associating "one or more" of these addresses with the current email, it is inherent for the e-mail addresses to be displayed to the user for such a selection.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 20 and 30 under 35 U.S.C. 102(e) over Ullmann, which contain essentially the same subject matter as claim 10, admitting the propriety of those rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MEK 11/26/2007

Conferees:


NATHAN FLYNN
SUPERVISORY PATENT EXAMINER


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100